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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,438	08/15/2008	Gerd Luedke	20030969-02	7675

22878 7590 02/05/2010  
AGILENT TECHNOLOGIES INC.  
INTELLECTUAL PROPERTY ADMINISTRATION,LEGAL DEPT.  
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LOVELAND, CO 80537

EXAMINER
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WHISENANT, ETHAN C

ART UNIT	PAPER NUMBER
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1634

NOTIFICATION DATE	DELIVERY MODE
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02/05/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

IPOPS.LEGAL@agilent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,438	<b>Applicant(s)</b> LUEDKE, GERD	
	<b>Examiner</b> Ethan Whisenant	<b>Art Unit</b> 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10 and 12-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>24 MAR 06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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**NON-FINAL ACTION**

1. The applicant's Preliminary Amendment filed 15 AUG 08 has been entered. Following the entry of the Preliminary Amendment, **Claim(s) 1, 3-8, 10 and 12-16** is/are pending.

**CLAIM OBJECTIONS**

2. **Claim(s) 6-7** is/are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Note that Claims 6-7 are dependent upon Claim 2, a claim that has been canceled.

**35 USC § 112- 2nd Paragraph**

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**CLAIM REJECTIONS under 35 USC § 112- 2ND PARAGRAPH**

4. **Claim(s) 1, 3-8, 10 and 12-16** is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 1** is indefinite because the phrase “having additional binding sites” is non-sequitur. As no first binding site(s) is/are recited how can there be “additional binding sites”.

#### **REASON FOR ALLOWANCE**

5. **Claims 1, 3-8, 10 and 12-14** would appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112 set forth in this Office action. Claims 1, 3-8, 10 and 12-14 are allowable over the prior art of record. The closest prior art discovered and evaluated during the examination is shown on the attached PTO-1449(s) and PTO-892(s). Independent Claim 1 is allowable over the prior art of record because none of the references of record alone teach all of the limitations recited in independent method Claim 1. Neither does the prior art of record, in any combination, reasonably suggest the method recited in independent Claim 1.

#### **35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

#### **Claim Rejections under 35 USC § 103**

7. **Claim(s) 15-16** is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Simons et al. [ US 2002/0119447 ] in view of the Stratagene Catalog [ p.39 (1988)]

Simons et al. teach a method of detecting HGBV which utilizes random hexamers (i.e. oligonucleotides with random sequences), a radiolabeled probe (i.e. a probe labeled with a first label, able to hybridize with a target nucleic acid) and

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agarose gel electrophoresis (i.e. a mass separator for separating nucleic acids according to their mass), See ¶ [0549]. Simons et al. do not teach a kit comprising the reagents necessary to practice their method. However, as evidenced by the Stratagene Catalog teaching, it was well known at the time of the invention to place the reagents needed to perform a nucleic acid based assay into a kit format. In addition, the Stratagene catalog teaches the advantages of assembling a kit, such as, saving resources and reducing waste. Therefore, absent an unexpected result, it would have been *prima facie* obvious to the ordinary artisan at the time of the invention to modify the teachings of Simons et al. with the teachings of the Stratagene Catalog wherein the reagents necessary to perform the method taught by Simons et al. are placed into a kit format. The ordinary artisan would have been motivated to make this modification in order to take advantage of the savings and efficiency afforded by kits.

**Claim 16** is drawn in part to an embodiment of the kit of Claim 15 wherein the kit comprises a second label for labeling the oligonucleotides of random sequence.

The ethidium bromide reagent of Simons et al. meets this limitation.

## CONCLUSION

**8. Claim(s) Claim(s) 1, 3-8, 10 and 12-16** is/are rejected and/or objected to for the reason(s) set forth above.

**9.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant whose telephone number is (571) 272-0754. The examiner can normally be reached Monday-Friday from 8:30 am -5:30 pm EST or any time via voice mail. If repeated attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Nguyen, can be reached at (571) 272-0731.

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The Central Fax number for the USPTO is (571) 273-8300. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989).

/Ethan Whisenant/  
Primary Examiner  
Art Unit 1634

## EXAMINER SEARCH NOTES

**19 OCT 09 - ECW**

**Databases searched: USPATFULL, USPG-PUBS, JAPIO and EUROPATFULL via EAST &**

**CAplus, Medline and BIOSIS via STN**

Reviewed the parent(s), if any, and any search(es) performed therein : see the BIB data sheet

Reviewed, the search(es), if any, performed by prior examiners

Search terms:

Inventor(s) : e.g. Luedke G?/au

Nucleic or DNA or RNA

Probe\$

Hybridiz\$

Southern or Northern

Alternativ\$

Solution or in solution

Random

Random (hexamer\$ or oligonucleotide\$)

Random sequence\$

Label\$

Microfluidic

Cappilar\$